

REMARKS

Claims 1, 14-21, 34, 44 and 46-47 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 2, 34, 37, 39-41, 44 and 47 Under 35 U.S.C. §102(e)

Claims 1, 2, 34, 37, 39-41, 44 and 47 stand rejected under 35 U.S.C. §102(e) as being anticipated by Robarts (US Patent 6,842,877). Withdrawal of this rejection is respectfully requested for at least the following reasons. Robarts does not disclose each and every limitation of the claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

All of the claims in some form recite the limitations *adusting/adapting/altering the priority of one or more e-mails based on a user's interaction with the one or more e-mails*, the user's interaction with the one or more e-mails comprising at least one of *a time of response to an e-mail, reading the e-mail, deleting the e-mail and ignoring the e-mail* (or at least one of how fast a user responds to an e-mail, whether the user reads the e-mail and whether the user deletes or saves the e-mail). Robarts does not disclose these novel features of the subject claims. For at least the foregoing reasons, applicants' representative respectfully requests that this rejection be withdrawn.

II. Rejection of Claims 6, 12, 13, 16, 30 and 33 Under 35 U.S.C. §103(a)

Claims 6, 12, 13, 16, 30 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts and Subramonian (US Patent 6,701,362). Applicants' representative respectfully submits that the claims as submitted in the previous amendment are patentable over

the cited art. However, in order to expedite prosecution, claims 6, 12, 13, 30 and 33 have been cancelled. Moreover, withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Robarts nor Subramonian, either alone or in combination, teach or suggest all of the claim limitations. Claim 16 depends from claim 1 and as explained above claim 1 is patentable over Robarts. Subramonian does not remedy the deficiencies of Robarts. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

III. Rejection of Claims 14, 17, 18, 20-22, 31, 35 and 42 Under 35 U.S.C. §103(a)

Claims 14, 17, 18, 20-22, 31, 35 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian and Wichelman (US Patent 6,590,587). Applicants' representative respectfully submits that the claims as submitted in the previous amendment are patentable over the cited art. However, in order to expedite prosecution, claims 22, 31, 35 and 42 have been cancelled. Moreover, withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Robarts nor Subramonian nor Wichelman, either alone or in combination, teach or suggest all of the claim limitations. Claims 14, 17, 18 and 21 depend from claim 1 and as explained above claim 1 is patentable over Robarts and Subramonian. Wichelman does not remedy the deficiencies of Robarts and Subramonian. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

IV. Rejection of Claim 15 Under 35 U.S.C. §103(a)

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian and Battat (US Patent 6,289,380). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Robarts nor Subramonian nor Battat, either alone or in combination, teach or suggest all of the claim limitations. Claim 15 depends from claim 1 and as explained above claim 1 is patentable over Robarts and Subramonian. Battat does not remedy the deficiencies of Robarts and Subramonian. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

V. Rejection of Claim 19 Under 35 U.S.C. §103(a)

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian, Wichelman and Simonoff (US Patent 6,078,322). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Robarts nor Subramonian nor Wichelman nor Simonoff, either alone or in combination, teach or suggest all of the claim limitations. Claim 19 depends from claim 17 and as explained above claim 17 is patentable over Robarts, Subramonian and Wichelman. Simonoff does not remedy the deficiencies of Robarts, Subramonian and Wichelman. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

VI. Rejection of Claims 23-25, 32 and 46 Under 35 U.S.C. §103(a)

Claims 23-25, 32 and 46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian and Giles (US Patent 6,437,812). Applicants' representative respectfully submits that the claims as submitted in the previous amendment are patentable over the cited art. However, in order to expedite prosecution, claims 23-25 and 32 have been cancelled. Moreover, withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Robarts nor Subramonian nor Giles, either alone or in combination, teach or suggest all of the claim limitations. Claim 46 recites the limitation the scope user interface *modifies prioritization decisions based on the user's interaction with the scope user interface*, the user's interaction comprising at least one of *how fast a user responds to a prioritized e-mail, whether the user reads the prioritized e-mail and whether the user deletes or saves the prioritized e-mail*. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

VII. Rejection of Claims 26 and 27 Under 35 U.S.C. §103(a)

Claims 26 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian, Giles and Simonoff (US Patent 6,078,322). Applicants' representative respectfully submits that the claims as submitted in the previous amendment are patentable over the cited art. However, in order to expedite prosecution, claims 26 and 27 have been cancelled.

VIII. Rejection of Claim 28 Under 35 U.S.C. §103(a)

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robarts, Subramonian, Giles and Tanaka (US Patent 5,471,399). Applicants' representative respectfully submits that claim 28 as submitted in the previous amendment is patentable over the cited art. However, in order to expedite prosecution, claim 28 has been cancelled.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP248US]. Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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